Supreme Court of the United States

October Term, 1975

No. 75-1405

MARSHALL FIELD & CO.,
Petitioner,

vs.

MARIAN SHOUP,
Respondent.

PETITION FOR REHEARING

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To The Honorable, the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your Petitioner, Marshall Field & Co., respectfully prays for reconsideration under the provisions of Rule 58, Paragraph 2, of the Supreme Court Rules, of the denial on May 19, 1976 of the Petition For Writ Of Certiorari.

The grounds for this Petition For Rehearing were available to Petitioner at the time of filing the Petition For Writ Of Certiorari, but were not presented therein.

The grounds set forth in the Petition For Writ Of Certiorari were the Respondent's lack of title to the patent in suit as determined by the controlling statutes and hence the Respondent's lack of capacity to sue for infringement of the patent. It was there demonstrated that title to the patent resides in a third party, Shoup Engineering Corporation, and Petitioner remains vulnerable to an action for infringement by the true owner of the patent.

Because the right of a party to be sued for patent infringement only by the owner of the patent is so fundamental and well established, it was difficult to cite a conflicting decision in other circuits on this precise issue of title to a patent. However, the Petition For Writ Of Certiorari cited prior decisions regarding the issue of title to copyrights rendered by this Court and by the Second Circuit Court of Appeals which are in conflict with the decision below.

Although there were other erroneous holdings of the Court below directed to the issue and validity of the patent which could have been presented by the Petitioner, this was not done because the issue of title appeared to be clear-cut and the error of the ruling on title seemed to be manifest.

Petitioner now requests this Court to consider the matter that the patent in suit is *invalid on its face* and without the need for considering any evidence such as the prior art patents showing the same structure and arrangement. The reason the patent in suit is invalid on its face is that it clearly does not meet the mandate of 35 U.S.C. 112 which sets forth the legal requirements for obtaining a patent monopoly.

The second paragraph of Section 112 of Title 35, United States Code (the patent statutes), reads:

> "The specification shall conclude with *one or more claims particularly pointing out and distinctly claiming* the subject matter which the applicant regards as his invention. A claim may be written in independent or dependent form, and if in dependent form, it shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim."

The Shoup patent in suit No. 3,174,863 is before the Court as Appendix F in the Additional Appendix To Petition For Writ Of Certiorari.

The patent is directed to a broiler having in a housing or rectangular box three principal parts:

> (a) A food supporting grill above upon whatever food to be cooked is placed;
>
> (b) A heating element (a zig-zag electric resistance wire) positioned below the food supporting grill; and
>
> (c) A pan or surface below the heating element and into which grease from the food being cooked (if it is a fat-containing food) drops and collects.

The claims of the patent are directed to a *first* spacing between (a) the food supporting grill and the heating element and a *second* spacing between the heating element and the grease collecting pan or surface below. The invention is purportedly directed to the idea of having these two spaces of such dimensions that the grease does not become overheated and hence does not flame and smoke.

This critical "spacing", upon which the patent depends, is defined in the claims in such an indefinite, vague, and meaningless way that *no one* can determine what this spacing must be in order to come within the patent monopoly, *or* to avoid or escape the patent monopoly.

Claim 1 of the patent "defines" the first space (between the food supporting grill and the heating element) by the words "means for supporting said grill A DISTANCE ABOVE said heating element SO THAT the

temperature of the grill as heated by the heating element is below the smoke and flame temperature range" (that is, no flaming and smoking).

Claim 1 "defines" the second space (between the heating element and the grease pan below) by the words "said heating element being SPACED A SUFFICIENT DISTANCE ABOVE a surface on to which the fats fall SO THAT said surface as heated by the heating element operates below the smoke and flame temperature range" (that is, no flaming and smoking).

Claim 2 similarly "defines" this same first distance by the words "SPACING said grill a SUFFICIENT DISTANCE above the heating element" to avoid flaming and smoking, and "defines" this same second distance by the words "SPACING said heating element A SUFFICIENT DISTANCE ABOVE a lower surface on to which said fats fall SO THAT" flaming and smoking is avoided.

Claim 3 similarly "defines" this first distance by the words "supporting the grill A DISTANCE ABOVE said heating element SO THAT" flaming and smoking is avoided, and "defines" this second distance by the words "a fat collecting pan spaced A SUFFICIENT DISTANCE BELOW said heating element SO THAT" flaming and smoking is avoided.

Claim 4 similarly "defines" this first distance by the words "supporting said grill A DISTANCE ABOVE said heating element SO THAT" flaming and smoking is avoided, and "defines" this second distance by the words "said heating element being SPACED A SUFFICIENT DISTANCE above a surface on to which the fats fall SO THAT" flaming and smoking is avoided.

Claim 5 similarly "defines" this first distance by the words "means for supporting said grill A DISTANCE ABOVE said heating element SO THAT" flaming and smoking is avoided, and "defines" this second distance by the words "said heating element being SPACED A SUFFICIENT DISTANCE ABOVE a surface on to which the fats fall SO THAT" flaming and smoking is avoided.

Claim 6 similarly "defines" this first distance by the words "supporting said grill A DISTANCE ABOVE said heating element SO THAT" flaming and smoking is avoided, and "defines" this second distance by the words "said heating element being SPACED SUFFICIENTLY ABOVE a surface on to which the fats fall SO THAT" flaming and smoking is avoided.

NO ONE can determine from *inspection or measuring* of a physical broiler whether or not that broiler has its three parts spaced apart such distances that it comes *within* the patent monopoly and hence infringes, or is outside of the patent monopoly and hence does not infringe.

The many, many factors which determine whether or not flaming and smoking occurs in a broiler, include among others:

(1) The then prevailing room temperature,

(2) The residual heat which might be in the broiler from preheating or from prior broiling,

(3) The temperature to which the heating element happens to be set by the operator,

(4) Whether the food being cooked contains any fat (bread being toasted or bacon being broiled),

(5) The relative amount of fat in meat being cooked (lean meat or very fat meat),

(6) The kind of meat (pork, beef, chicken, or lamb), the fat in each having a different kindling point when flame and smoke is produced, and

(7) The amount of fat allowed to collect in the grease pan before being emptied, and hence subjected to heat.

(8) The time period during which the collected grease is subjected to the heat.

A manufacturer of broilers cannot determine *from the patent claims* whether or not a broiler being manufactured comes within the patent monopoly.

A retail store, such as Petitioner, cannot determine *from the patent claims* whether or not a broiler being retailed comes within the patent monopoly.

A housewife using a broiler, such as a customer of the Respondent, cannot determine whether or not a broiler she is using comes within the patent monopoly.

None of these classes of potential infringers, manufacturer, seller, and user, has any way in order to determine from the patent whether or not a certain broiler infringes.

A Court, likewise, has no way whatever to properly determine from the patent whether or not a certain accused broiler is an infringing broiler.

The *critical importance* to the public of 35 U.S.C. 112 requiring that a valid patent must have "*claims particularly pointing out and distinctly claiming*" the invention, is to be recognized. Without this essential safeguard provided by 35 U.S.C. 112, the public is left in a most dangerous and perilous position.

Another way of expressing the requirements of this statute is to state that a patent must contain claims which provide adequate "no trespassing signs". Without such adequate "no trespassing signs", trespassing may not be avoidable, and an innocent member of the public may be entrapped as an infringer.

The lower courts have generally recognized the critical need of distinct, definite claims for defining the boundaries of a patent monopoly. This need for such distinctly marked boundaries for protecting the public interest was aptly phrased in a decision of the District Court for Maryland, in which it stated:

> "*The claims should point out the limits* of the patent. Where they do not, they fail in their purpose of describing the *boundaries* of the invention, within which no one may properly operate unless licensed under the patent; outside of which the field is open to the public. *Where such 'no trespassing' signs are not properly posted defining* the protected boundaries, the claims are invalid."
>
> *Marshall v. Procter & Gamble Mfg. Co.*, 210 F. Supp. 619; 135 U.S.P.Q. 239 (D.Ct., Md., 1962)

If one were looking for a *prime example* of a patent wrongfully issued by the Patent Office because it does not include reasonable and definite "no trespassing signs", this Shoup patent would be that patent.

Of course, there could be no suggestion of an invention in a "discovery" that grease or greasy food will flame and smoke if it is subjected to too much heat for too long. It is ancient knowledge possessed by every housewife and every camper who cooks that if one holds greasy food or grease *too close* to the heat for *very long*, flaming and smoking will occur. Since this

phenomenon is ancient knowledge, any "invention" must reside in structure.

The Shoup patent claims are not "particularly pointing out and distinctly claiming" the invention, and hence does not in any degree meet the requirements of 35 U.S.C. 112 set up by Congress to protect the public.

Wherefore, Shoup patent No. 3,174,863 (Appendix F in Additional Appendix To Petition For Writ Of Certiorari) is *invalid on its face.*

Relief is in order when Petitioner has been held liable for trespassing on property not owned by the Respondent and the boundaries of the property are not known or marked. The patent in suit is owned by another and the patent monopoly is not defined with distinct or fixed boundaries by the claims, all contrary to the express statutory conditions for obtaining a valid patent.

The public should not be subjected to such actions by non-owners of such an undefined and nebulous patent monopoly.

If the decision below represents the law of patents, then how can an attorney intelligently advise a client who is confronted with a demand for payment from one not owning a patent and which patent has no defined limits of its monopoly?

In view of the most favorable attitude toward patents by the Court of Appeals of the Seventh Circuit as compared with other Circuits, it is extremely unlikely that the Shoup patent, with all its frailties, will ever be put to a test in any other Circuits. Hence, a con-

flict between Circuits involving this particular patent is most improbable. Only a sharp conflict of principles of law is here present.

Reconsideration is believed to be deserved. Hence, the Petitioner requests that this Petition For Rehearing be granted, and that review be ordered.

Respectfully submitted,

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